

REMARKS/ARGUMENTS

Applicant acknowledges receipt of the Office Action dated October 14, 2009. By this Response, new claims 31-33 are added; claims 16, 18, 26, and 30 are cancelled; and claims 13-15, 17, 19-25, and 27-29 are amended. Claims 13-15, 17, 19-25, 27-29, and 31-33 are now pending in the application. The Examiner rejected claims 1-12 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner also rejected claims 1-12 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In addition, the Examiner rejected claims 1-12 under 35 U.S.C. § 103 as being unpatentable over Pickford et al., WO 03/089023 ("*Pickford*") in view of O'Brien et al., U.S. Patent No. 7,488,343 ("*O'Brien*") and Rosenberg et al., U.S. Patent No. 5,185,075 ("*Rosenberg*"). Applicant believes the pending claims are allowable over the art of record and respectfully requests reconsideration and allowance of all claims.

Applicant would like to respectfully note that the Examiner based the rejections of this Office Action on claims 1-12. However, claims 1-12 were not pending in this application at the time of the Office Action. A Third Preliminary Amendment was filed by the Applicant on January 26, 2009 by which claims 1-12 were cancelled, and new claims 13-30 were added.

I. 35 U.S.C. § 112, second paragraph – Claims 1-12 have been cancelled.

The Examiner rejected claims 1-12 as being indefinite. Please note that claims 1-12 were cancelled by the Third Preliminary Amendment filed on January 26, 2009.

II. 35 U.S.C. § 112, first paragraph – Claims 1-12 have been cancelled.

The Examiner rejected claims 1-12 as failing to comply with the enablement requirement. Please note that claims 1-12 were cancelled by the Third Preliminary Amendment filed on January 26, 2009.

III. Unpatentability over *Pickford* in view of *O'Brien* and *Rosenberg* - Claims 1-12 have been cancelled.

The Examiner rejected claims 1-12 as being unpatentable over *Pickford* in view of *O'Brien* and *Rosenberg*. Please note that claims 1-12 were cancelled by the Third Preliminary Amendment filed on January 26, 2009.

IV. All pending claims 13-15, 17, 19-25, 27-29, and 31-33 are allowable.

Claims 13-15, 17, 19-25, 27-29, and 31-33 have been added or amended by the Third Preliminary Amendment filed on January 26, 2009 and by this Response.

Claim 13 is an independent claim upon which claims 14, 15, 17, 19-23, and 31 depend. Claim 24 is an independent claim upon which claims 25, 27-29, 32, and 33 depend. All such claims are allowable. For instance, nothing in *Pickford* in view of *O'Brien* and *Rosenberg* teach or suggest all recitations of independent claims 13 and 24. Claim 13 recites "said implant comprising as said surface layer an anodized hard layer including pits in said hard layer, said pits including a softer and more porous material than the hard layer, said hard layer and said pits including ions of said biocidal metal material as a result of ion exchange, with said more porous material in the pits having absorbed biocidal metal material to a larger extent than said hard layer." Claim 24 recites "wherein the anodising generates a dense hard surface layer and also shallow pits in the surface layer which are filled with a somewhat softer and more porous material." Nothing in *Pickford* teaches these recitations such as a dense hard surface layer and also shallow pits in the surface layer. Nothing in *O'Brien* and *Rosenberg* provide the missing recitations to *Pickford*.

Claim 24 also recites "anodising the implant at a voltage above 50 volts for a period of at least 30 minutes, so as to generate the surface layer, wherein the anodising generates a dense

hard surface layer and also shallow pits in the surface layer which are filled with a somewhat softer and more porous material.” Nothing in *Pickford* teaches these recitations, and nothing in *O’Brien* and *Rosenberg* provide the missing recitations to *Pickford*. For instance, *O’Brien* teaches that the anodising is stopped when the current flow has dropped, and the color has developed “usually in much less than one minute.” (*O’Brien*, col. 11, ln. 65-col. 12, ln. 2) *Rosenberg* teaches applying a voltage that may be increased to a preset maximum with the current then decaying to a steady state, which indicates that at “the end of age down, the film no longer becoming more resistive with the passage of current. There is usually no point in continuing” and “[i]t may be desirable to terminate the anodizing cycle prior to the completion of age down.” (*Rosenberg*, col. 7, lns. 6-59) Therefore, *O’Brien* and *Rosenberg* teach carrying out anodization in a much shorter time than that required by claim 24.

In view of the recitations in independent claims 13 and 24 that are neither taught nor suggested by cited references *Pickford*, *O’Brien*, and *Rosenberg*, Applicant respectfully submits that independent claims 13 and 24 are allowable over the cited art. Consequently, Applicant requests that the Examiner allow independent claims 13 and 24 and the claims dependent thereto.

V. Conclusion

Applicant respectfully requests reconsideration, allowance of the pending claims and a timely Notice of Allowance be issued in this case. If the Examiner feels that a telephone conference would expedite the resolution of this case, the Examiner is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, Applicant may have at times referred to claim limitations in shorthand fashion or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood

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that there may be other distinctions between the claims and the prior art that have yet to be raised but which may be raised in the future.

Respectfully submitted,

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